

**Remarks**

Claims 1, 4, 14-16, 33 and 34 are pending in the present application.

Claims 1, 4, 33 and 34 have been amended. Claims 5-13, 17-32 and 35-38, inclusive, have been canceled.

**Amended Claims 1, 4, 33 and 34.**

Claim 1 has been amended to specify that the pharmaceutical composition comprises a nucleic acid encoding for an active human src protein and that the composition is administered directly to a tissue to stimulate angiogenesis in the tissue. Support for this amendment can be found throughout the application, e.g., direct administration of nucleic acids to a tissue to stimulate angiogenesis is described on page 25, lines 4-5 and in the Examples; a nucleic acid encoding a human src protein is shown in FIG. 3 and described on page 4, lines 5-9.

Claim 4 has been amended to depend from claim 1.

Claims 33 and 34 have been amended to specify that the nucleic acid encode for a human src protein having the amino acid residue sequence of SEQ ID NO: 5 (human c-src). Support for this amendment can be found on page 9, line 9.

No new matter is added by any of these amendments.

**Objections to the Claims are Moot.**

Claims 12 and 13 were objected to as not properly limiting claim 1, from which they depend. Claims 12 and 13 have been cancelled, rendering these objections moot.

**Claims 1, 4 and 14-16 are Enabled.**

Claims 1, 4 and 14-16 stand rejected under the first paragraph of 35 U.S.C. §112 as purportedly lacking enabling support in the specification. Page 3 of the Office Action states that the application is enabling for: "pharmaceutical compositions comprising a nucleic acid encoding an active src protein that can be used to potentiate angiogenesis in a tissue at a site at which the active src protein has been directly administered." The presently pending claims 1, 4, and 14-16 comprise just such pharmaceutical compositions. Accordingly, claims 1, 4, and 14-16 are enabled, and this ground for rejection should be withdrawn.

**Claims 1, 4 and 14-16 are Not Indefinite.**

Claims 1, 4 and 14-16 stand rejected under the second paragraph of 35 U.S.C. §112 as purportedly being indefinite. In particular, objection was made to the phrase "a tissue associated with a disease condition" in claim 1. Since the claim 1 no longer includes the purportedly objectionable phrase, this ground for rejection is moot.

**Claims 1, 4, 14-16, and 33-34 are Not Anticipated by the Applied References.**

Claims 1, 4, 14, 16, and 34 have been rejected as allegedly being anticipated by Zang *et al.* This rejection is unwarranted and should be withdrawn. Zang *et al.* is directed exclusively to chicken c-src (Y527F is a variant on the chicken sequence). The presently pending claims are directed to compositions comprising a nucleic acid encoding an active human src protein. The applied reference does not teach or suggest nucleic acids encoding an active human src protein. In addition, claim 34 specifies that the nucleic acid encode a protein having the amino acid residue sequence of SEQ ID NO: 5. Zang *et al.* certainly does not teach or suggest a nucleic acid encoding the amino acid sequence specified by claim 34. Accordingly, claims 1, 4, 14, 16 and 34 are patentable over Zang *et al.*

Claims 1, 4, 15, and 34 have been rejected as allegedly being anticipated by Dent *et al.* This rejection is unwarranted, as well. Dent *et al.* is also directed exclusively to chicken c-src (again the Y527F variant is utilized). As noted above, the presently pending claims are directed to compositions comprising a nucleic acid encoding an active human src protein. The applied reference does not teach or suggest nucleic acids encoding an active human src protein. Furthermore, claim 33 specifies that the nucleic acid encode the protein of SEQ ID NO: 5. Dent *et al.* does not teach or suggest such a nucleic acid. Accordingly, claims 1, 4, 15, and 33 are patentable over Dent *et al.*

Page 9 of the Office Action states that "application of printed matter to an old article cannot render the article patentable." Applicants respectfully submit that this is an incorrect statement of the law. In support of this statement, the Office Action provides a list of case law dating from the 1920's to the 1940's. Case law prior to the passage of the Patent Act of 1952 is simply not applicable on the issue of the patentable weight to be given to printed matter. The more recent case law, in particular *In re Gulack*, and *In re Miller*, fully supports the proposition that printed matter can lend patentable weight to a claim.

See *In re Gulack*, 217 U.S.P.Q. 401, 403 (C.C.P.A. 1983):

"Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter ... A printed matter rejection is based on case law antedating the 1952 patent act ... The 1952 act legislatively revised that approach through its requirement that the claims be viewed as a whole ..."

See also *In re Miller*, 164 U.S.P.Q. 46, 49 (C.C.P.A. 1969):

"... printed matter, in an article of manufacture claims, can be given patentable weight ... no attempt is here being made to patent printed matter as such. The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination ... The solicitor seems to urge that we ignore the claim limitations to the legends because they are printed and because printed matter is not patentable subject matter by itself ... we reject that argument."

In *Gulack*, the invention was a band imprinted with a series of digits derived from a mathematical algorithm. The band could be a hat band, for example, having utility on its own. The printed matter on the band conveyed a new utility to the band, i.e., it was now useful for performing "magic tricks" and for displaying various aspects of number theory. The CCPA found that the band supported the numbers and the numbers had a relationship to each other that provided a new utility to the band.

Similarly in *Miller*, the invention was a measuring cup. Without the printed matter, the cup had a utility of its own. With the printed matter, the measuring cup had a new and distinct utility (facilitating the preparation of fractional portions of a recipe without the need for mathematical calculations). The printed matter was specifically claimed to be "on" the cup, and this sufficed to provide the structural relationship necessary to carry out the invention.

Here, the label is supported by the packaged composition. The information on the label provides utility to the packaged article, as a whole. As such, the label adds patentable weight to the claimed article of manufacture.

January 8, 2004

**Conclusion.**

All of the presently pending claims are deemed patentable over the applied art.  
Reconsideration and early passage of this application to issue is earnestly solicited.

Respectfully submitted,

Dated 8 January 2004

By Talivaldis Cepuritis  
Talivaldis Cepuritis (Reg. No. 20,818)

OLSON & HIERL, LTD.  
20 North Wacker Drive  
36th Floor  
Chicago, Illinois 60606  
(312) 580-1180